

### **REMARKS**

Reconsideration of the application is respectfully requested.

Claims 1, 7, 13 and 15 have been amended. Claims 2-3, 6, 8, 12, 14 and 16 were previously cancelled. All amendments are fully supported by the original specification and drawings. No new matter has been added. Claims 1, 4-5, 7, 9-11, 13 and 15 remain pending.

### **DOUBLE PATENTING REJECTION**

Claims 13 and 15 were provisionally rejected as being unpatentable over claim 1 of copending Application No. 10/550,925 on the ground of nonstatutory obviousness-type double patenting. Applicants have amended the claims to ensure that the claims in both applications are patentably distinct. Therefore, reconsideration of this rejection is respectfully requested. However, should Examiner maintain the rejections, in the interest of bringing prosecution to a conclusion, Applicants will submit a Terminal Disclaimer on allowance of the pending claims, notwithstanding Applicants disagreement with the Examiner's conclusion.

### **CLAIM REJECTIONS UNDER 35 U.S.C. § 112**

In the Office Action, claim 13 was rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Specifically, the Examiner stated that it was unclear why the user would be allowed a smaller function set in a second mode in which the user was successfully authenticated.

Applicants thank the Examiner for interpreting the claim in line with independent claims 1, 7 and 15. Applicants have amended the claim to recite a smaller function set in a second mode in which the user was not successfully authenticated. Therefore, Applicants respectfully submit that the amendment obviates this rejection as to claim 13.

### CLAIM REJECTIONS UNDER 35 U.S.C. § 102

In the Office Action, claims 1, 7, 9, 13 and 15 were rejected under 35 U.S.C. § 102 (b) as being anticipated by U.S. Patent Publication No. 2003/0129964 to Kohinata (hereinafter “Kohinata”). Applicants respectfully note that for a claim to be rejected under 35 U.S.C. § 102 (b), the prior art reference must clearly disclose each and every element of the claims in detail as complete as that which is claimed.

Specifically, the Examiner stated that “a finger is broadly interpreted as an object” (Office Action, Item 9, page 5 “Response to Arguments”).

Applicants respectfully disagree that “object” can be interpreted so broadly, in light of the specification and the ordinary and customary meanings of the terms, as to include a finger. During examination the claims must be given their broadest reasonable interpretation *in light of the specification*; words of the claim must be given their plain meaning unless inconsistent with the specification. *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989); *Chef America, Inc. v. Lamb-Weston, Inc.*, 358 F.3d 1371, 1372, 69 USPQ2d 1857 (Fed. Cir. 2004). The plain meaning is the ordinary and customary meaning, which is the meaning given to the term by those of ordinary skill in the art at the time of the invention. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313<, 75 USPQ2d 1321>, 1326< (Fed. Cir. 2005) (en banc), MPEP 2111.01. It is the use of the words **in the context of the written description and customarily by those skilled in the relevant art** that accurately reflects both the "ordinary" and the "customary" meaning of the terms in the claims. *Ferguson Beauregard/Logic Controls v. Mega Systems*, 350 F.3d 1327, 1338, 69 USPQ2d 1001, 1009 (Fed. Cir. 2003). See also MPEP 2111.01.

First, the specification uses the term “object” in a way that is inconsistent with an interpretation that includes body parts. Paragraph [0048] discusses “objects” as follows: “The random selection of articles/objects, in particular, an article/object that is "unique", and **is almost always in possession by the user only** may be just as secure as authenticating against a photograph of the user's face.” A finger or other body part cannot be described as “*almost* always in possession by the user only.” The preceding sentence in this paragraph

that refers to photographing a user's hand or feet does not use the terms "objects" to describe them.

Second, the ordinary and customary meaning of "object" does not include fingers. Instead, this term is generally understood by persons with skill in the art to mean a separate, individual item or unit. Applicants are unaware of any usage of the term "object" to include parts of the body. Applicants further note that the preceding arguments are equally applicable with respect to the term "article."

Nonetheless, in the interests of advancing prosecution, Applicants have amended independent claims 1, 7 and 15 (without prejudice) to recite "a photograph of an article" (claim 1); "a photograph of a non-anatomical object" (claim 7); "a photograph of an article or a photograph of a non-anatomical object (claim 13); or "a photograph of a manufactured article or a photograph of a non-anatomical object" (claim 15). These amendments are supported at least in paragraph [0048] (e.g. a ring, a watch, a spouse or child's picture) and in Figures 4a and 4b.

Kohinata cannot teach these features. Instead, the imaging of Kohinata is of the surface of the user's finger (a fingerprint; see paragraph [0043] and Fig. 1). Because a finger is not an "article," a "non-anatomical object" or a "manufactured article," Kohinata cannot teach every element of claims 1, 7, 13 or 15.

Therefore, Applicants respectfully submit that claims 1, 7, 13 and 15 are patentable over Kohinata under section §102 (b).

Claims 4-5 and claims 9-11 depend from claims 1 and 7 respectively, incorporating their recitations, and are thus also patentable over Kohinata for at least the same reasons.

### **CLAIM REJECTIONS UNDER 35 U.S.C. § 103**

In the Office Action, claims 4, 5, 10 and 11 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over Kohinata in view of U.S. Patent No. 6,883,716 to De Jong (hereinafter “De Jong”).

As discussed in the previous section of this response, independent claims 1, 7, 13 and 15 are in condition for allowance. Claims 4 and 5 and claims 10 and 11 depend from claims 1 and 7, respectively, incorporating their recitations. Therefore, dependent claims 4, 5, 10 and 11 are also allowable over the cited references.

Applicants take this opportunity to point out that De Jong cannot remedy the deficiencies of Kohinata with respect to the recitations of the amended claims. De Jong merely teaches a photo carrying identification device that does not include a camera.

Finally, in the “Response to Arguments” section of the OA (page 5, item 9), the Examiner states that Applicants’ arguments filed March 16, 2009 were not persuasive. Because Applicants’ arguments were directed in part to answering rejections based on U.S. Patent No. 6,377,699 to Musgrave et al., Applicants take this opportunity to note that Musgrave cannot remedy the deficiencies of Kohinata with respect to the recitations of the amended claims. Musgrave merely discloses a telephone with an integrated imager that photographs the iris of the user’s eye. As discussed above with regard to a finger, a body part is not an “article,” a “non-anatomical object” or a “manufactured article.”

Therefore, Applicants respectfully submit that all pending claims are in condition for allowance.

## CONCLUSION

In view of the foregoing, notice of allowance is solicited. If the Examiner has any questions concerning the present paper, the Examiner is kindly requested to contact the undersigned at (206) 381-8819. If any fees are due in connection with filing this paper, the Commissioner is authorized to charge the Deposit Account of Schwabe, Williamson and Wyatt, P.C., No. 50-0393.

Respectfully submitted,  
SCHWABE, WILLIAMSON & WYATT, P.C.

Date: June 23, 2009 by: Al AuYeung  
Al AuYeung  
Reg. No.: 35,432

**SCHWABE, WILLIAMSON & WYATT, P.C.**  
U.S. Bank Centre  
1420 5<sup>th</sup>, Suite 3010  
Seattle, Washington 98101  
Telephone: 206-622-1711